



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

MAY 12 2011

OFFICE OF PETITIONS

CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

In re Application of Liang et al.	:	
Reissue Application No. 09/637,764	:	
Reissue Filing Date: August 10, 2000	:	Decision on Petition
Reissue of Patent No. 5,791,422	:	
Original Issue Date: August 11, 1998	:	
Attorney Docket No. 36912/S61	:	

This is a decision on the petition under 37 C.F.R. § 1.47(a) filed March 3, 2011, which is being treated as a petition under 37 C.F.R. § 1.183 seeking waiver of 37 CFR §§ 1.172 and 1.175 to the extent the regulations require a supplemental declaration in a reissue application be executed by all the named inventors.

The petition under 37 C.F.R. § 1.183 is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.183."

The Petition is Properly Treated as a Petition Under 37 C.F.R. § 1.183

The instant petition was filed under 37 C.F.R. § 1.47(a). However, the provisions of 37 C.F.R. § 1.47 are not applicable once an oaths or declarations signed by all the inventors have been filed. In this case, reissue declarations signed by all the inventors were filed August 10, 2010. Therefore, the provisions of 37 C.F.R. § 1.47 are not applicable.

In order to have a substitute declaration accepted without the signature of an inventor who has previously signed a declaration, a petition under 37 C.F.R. § 1.183 must be filed and granted. See Manual of Patent Examining Procedure § 1414.01(III) (8th ed., Rev. 8, July 2010).

The \$200 petition fee required for a petition under 37 C.F.R. § 1.47 was charged to Deposit Account No. 03-1728 on March 4, 2011. The petition fee for a petition under 37 C.F.R. § 1.183 is \$400, not \$200. Therefore, an additional \$200 has been charged to the deposit account.

The Merits of the Petition Under 37 C.F.R. § 1.183

Each declaration filed March 3, 2011, is titled, "Substitute Declaration for Reissue Application." Therefore, the Office has assumed the declarations are *not* intended to be supplemental declarations, which only seek to correct the errors statement in a prior declaration.

Based on the Office's review of the record and the efforts made to obtain the signature of the non-signing inventor, the Office would normally conclude justice would be served by waiving the requirement for his signature on the substitute declaration filed March 3, 2011.

Unfortunately, the petition cannot be granted at this time because the substitute declaration is improper.

37 C.F.R. § 1.175 states a reissue oath or declaration must comply with the requirements set forth in 37 C.F.R. § 1.63 and comply with several requirements identified in 37 C.F.R. § 1.175. In other words, a reissue declaration must:

- (1) "Identify each inventor." 37 C.F.R. § 1.63(a)(2).
- (2) "Identify the country of citizenship of each inventor." 37 C.F.R. § 1.63(a)(3).
- (3) "State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed." 37 C.F.R. § 1.63(a)(4).
- (4) "State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in [37 C.F.R.] § 1.56." 37 C.F.R. § 1.63(b)(3).
- (5) "Unless such information is supplied on an application data sheet in accordance with § 1.76, ... [state the] mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor." 37 C.F.R. § 1.63(c)(4).
- (6) State "All errors being corrected in the reissue application up to the time of filing of the oath or declaration under [37 C.F.R. § 1.175(a)] arose without any deceptive intention on the part of the applicant." 37 C.F.R. § 1.175(a)(2).

The declarations filed March 3, 2011, fail to satisfy the six requirements identified above.

Requirements (1) and (2)

A reissue declaration must identify each inventor and the country of citizenship of each inventor. None of the declarations identify each of the inventors and each inventor's citizenship. For example, the declaration signed by Liang does not identify any inventor other than Liang.

Requirement (3)

A declaration must "[s]tate that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed." 37 C.F.R. § 1.63(a)(4). None of the declarations signed by the inventors state the

person making the declaration believes the inventor(s) named in the declaration being signed is the original and first inventor(s) of the subject matter which is claimed.

Requirement (4)

A declaration must “[s]tate that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in [37 C.F.R.] § 1.56.” 37 C.F.R. § 1.63(b)(3).

Although the declarations acknowledge a duty to disclose information “material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a),” none of the declarations acknowledge a duty to disclose information “material to patentability” as defined in 37 C.F.R. § 1.56.

The Office addressed the language necessary to satisfy the “duty to disclose” requirement for oaths and declarations in *Duty of Disclosure Language Set Forth in Oaths or Declarations Filed in Nonprovisional Patent Applications*, 1327 Off. Gaz. Pat. Office 112 (February 12, 2008). The Office stated,

In 1992, the Office amended 37 CFR 1.63 to conform to amendments made in 37 CFR 1.56. See Duty of Disclosure, 57 FR 2021 (January 17, 1992) (final rule). The amendments to 37 CFR 1.63(b)(3) resulted in “material to patentability as defined in § 1.56” replacing “material to the examination of the application in accordance with § 1.56(a).” Despite this amendment to 37 CFR 1.63(b)(3), some applicants in their oaths or declarations continue to use “material to the examination of the application” in place of “material to patentability,” and “in accordance with § 1.56(a)” in place of “as defined in § 1.56.” In response to proper objections made during the examination of pending patent applications, practitioners have argued that the oaths and declarations executed by applicants with the outdated language in question are proper and meet the requirements set forth in 37 CFR 1.63 in view of Comment 38 and the accompanying Reply in the 1992 Final Rule. See Duty of Disclosure at 2027. Additionally, these practitioners have argued that the outdated language should be accepted because the Office has not routinely enforced strict compliance with current 37 CFR 1.63, as evidenced by the number of pending patent applications and issued patents containing oaths or declarations with the outdated “material to examination” and “in accordance with 37 CFR 1.56(a),” language....

With this Notice, the Office is putting applicants and their representatives on notice that compliance with the express language of 37 CFR 1.63 will now be required. If an oath or declaration filed on or after June 1, 2008, does not include the express language set forth in 37 CFR 1.63(b)(3), the Office will object to the oath or declaration as failing to comply with 37 CFR 1.63. A supplemental oath or declaration pursuant to 37 CFR 1.67 will then be required.

In view of the prior quoted language, the “duty to disclose” language in the declarations filed March 3, 2011, is insufficient to constitute a proper acknowledgment of a duty to disclose information material to patentability as defined in 37 C.F.R. § 1.56.

Requirement (5)

A proper declaration must list the mailing address, and residential address if different than the mailing address, for each inventor unless an application data sheet has been filed.

None of the individual declarations include addresses each and every inventor and an application data sheet has not been filed.

Requirement (6)

A proper declaration must state, “All errors being corrected in the reissue application up to the time of filing of the oath or declaration under [37 C.F.R. § 1.175(a)] arose without any deceptive intention on the part of the applicant.” 37 C.F.R. § 1.175(a)(2).

The declarations state, with emphasis added,

Every error in the patent which was corrected in the present reissue application, *and is not covered by a prior oath/declaration* submitted in this application, arose without deceptive intention of the part of the applicant.

The required statement in the declaration must include *all* errors being corrected. The statement in the declarations does not include errors being corrected covered by prior oaths or declarations. The fact an error may have been covered in a prior declaration will not remove the requirement for the error to be “covered” in subsequent declarations if a party is still seeking to correct the error.

Conclusion

In view of the prior discussion, the declaration listing the non-signing inventor’s name will not be accepted without the non-signing inventor’s signature because the declaration, as well as the declarations signed by the other inventors, is improper. Any request for reconsideration should include a proper declaration.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.¹
Document Code “PET.OP” should be used if the request is filed electronically.

By facsimile: (571) 273-8300
Attn: Office of Petitions

¹ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney
Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions